

DOCKET NO: 218203US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

INVENTOR APPLICATION OF:

: EXAMINER: SPIEGLER, A. H.

Akihiro YOKOYAMA, et al.

: ART UNIT: 1637

SERIAL NO.: 10/046,313

: PATENT NO.: 6,893,847

FILED: JANUARY 16, 2002

: ISSUED: MAY 17, 2005

FOR: OLIGONUCLEOTIDE FOR DETECTING SALMONELA AND METHOD OF  
DETECTING SALMONELLA

LETTER TO PTO

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants with to make of record the following documents from U.S. 11/130,137,  
which is a continuation of the above-identified application and was filed on May 17, 2005:

- 1) A copy of the Preliminary Amendment filed on May 17, 2005 (11 pages);
- 2) A copy of the Office Action mailed December 11, 2006 (4 pages); and
- 3) A copy of the List of References Cited by Applicants (Form PTO-1449) filed on October 12, 2005, and acknowledged as being considered by the Examiner on December 7, 2006, as evidenced by the Examiner's initials next to the cited references and signature at the bottom of each page (3 pages).

Respectfully submitted,

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MAIER & NEUSTADT, P.C.  
Norman F. Oblon

Vincent K. Shier, Ph.D.  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/130,137	05/17/2005	Akihiro Yokoyama	272600US0CONT	3660
22850	7590	12/11/2006		
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER WILDER, CYNTHIA B				
ART UNIT		PAPER NUMBER		
1637				

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED: 12/12/06  
OBLON, SPIVAK, MCCLELLAND  
MAIER & NEUSTADT, P.C.  
FEDERAL BUREAU OF INVESTIGATION  
Initials/Date Dispatched: HIR 12/12/06  
Type of Response: 151 RD  
Due Date: 3/14/07



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**Office Action Summary**

Application No.

11/130,137

Applicant(s)

YOKOYAMA ET AL.

Examiner

Cynthia B. Wilder, Ph.D.

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,5,7 and 9-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5,7 and 9-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/2005 and 5/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. Applicant's preliminary amendment filed on 5/17/2005 is acknowledged. Claims 1-2, 4, 6, and 8 have been canceled. Claims 2, 5, 7 have been amended. Claims 9-19 have been added.

#### ***Double Patenting***

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 3, 5, 7, 9-19 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-14 of prior U.S. Patent No. 6,893,847 B2. This is a double patenting rejection.

#### ***Conclusion***

4. No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia B. Wilder, Ph.D. whose telephone number is (571) 272-0791. The examiner can normally be reached on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

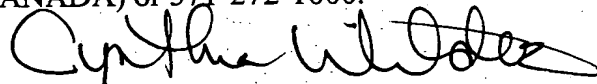
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cynthia B. Wilder, Ph.D.  
Patent Examiner  
Art Unit 1637

12/7/2006